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| EXAMINER |
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O'CONNOR, GERALD J

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| ART UNIT | PAPER NUMBER |
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3627

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06/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/076,337

Applicant(s)

Wilmes et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 26, 2007 (RCE and Amdt).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 26-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 15, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 26, 2007 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on February 26, 2007 in reply to the previous Office action on the merits, mailed November 15, 2006.

3. The amendment of claims 1, 26, 30, 33, and 34 by applicant in the reply filed February 26, 2007 is hereby acknowledged.

Response to Amendment

4. The amendment submitted February 26, 2007 fails to comply with 37 CFR 1.121(c) because it fails to indicate the changes to "currently amended" claim 33 (adding back that which was deleted by the previous amendment on January 16, 2007) and because it fails to indicate the correct status ("currently amended") for claim 33. The paper has been entered, but all future amendments *must* comply with 37 CFR 1.121.

Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the examiner has cited the references on form PTO-892, they have not been considered.

Specification

6. The disclosure is objected to because it contains embedded references to unavailable, external, third-party materials, which materials are neither currently available, nor part of the instant prosecution record. Applicant is required to either delete all such references to external materials, or else provide a copy of all such referenced external materials. See MPEP § 608.01.

Claim Objections

7. Claims 1-14 are objected to because of the following informality: it appears that “said tax information system, and a tax information system comprising” (claim 1, lines 5 and 6) was intended to be --a tax information system, said tax information system comprising--, which change will be assumed for purposes of further consideration of the claims hereinbelow. Appropriate correction is required.

Claim Rejections - 35 USC § 112, First Paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to disclose, in an adequately enabling manner, how the "VoIP" embodiment would function (enable voice transmissions via a digital computer data network), nor does the specification adequately disclose how the invention would be practiced by means of voice communication rather than data communication (i.e., such that it could be performed using an ordinary voice telephone).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 1-14 and 26-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan (US 2003/0093320).

Sullivan discloses a transaction tax settlement system comprising: a personal communication device configured to participate in a transaction; a communication network providing two-way communication between said personal communication device and a tax information system, said tax information system comprising: a tax directory having a listing of tax authorities stored thereon, said tax directory configured to facilitate identification of certain of said tax authorities capable of imposing a tax on said transaction; said tax directory configured to return a list of said identified tax authorities to said personal communication device; said personal communication device configured to send a request directly to said identified tax authorities, wherein said request includes information relating to said transaction; and, a tax authority calculator corresponding to each of said identified tax authorities, said tax authority calculator configured to facilitate determination of a tax rate on said transaction, wherein said tax rate is returned directly to said personal communication device (see, in particular, Figure 15B and ¶¶ 3, 5, 7, 42, 47, 61-63, 65, and 66).

Regarding claims 2, 27, and 35, tax information system of Sullivan further comprises an authorization authority configured to validate a payment modality.

Regarding claim 3, in the system of Sullivan, the tax directory identifies said tax authorities upon receipt of a request, said request including a factor of said transaction.

Regarding claim 4, in the system of Sullivan, the factor comprises at least one of location data, a description of said transaction, and a tax status of a party participating in said transaction.

Regarding claim 5, in the system of Sullivan, the personal communication device is configured to submit a request to said tax information system, said request including factors pertaining to said transaction.

Regarding claim 6, in the system of Sullivan, the tax directory is configured to receive said request and return to said personal communication device information on each of said identified tax authorities.

Regarding claims 7-9, in the system of Sullivan, the returned information includes any of: a location of each of said identified tax authorities; a domain name for each of said identified tax authorities; or, a URI of each of said identified tax authorities.

Regarding claim 10, in the system of Sullivan, the tax information system returns to said personal communication device a location of said tax authority calculator.

Regarding claim 11, in the system of Sullivan, the location includes a domain name of said tax authority calculator.

Regarding claim 12, in the system of Sullivan, the location includes a URI of said tax authority calculator.

Regarding claim 13, in the system of Sullivan, the tax rate comprises at least one of a monetary value, a tax table, and a rule.

Regarding claims 14, 29, and 36, in the system of Sullivan, the factor comprises a location data received from at least one of a seller point of presence, said personal communication device, and a participating third party.

Regarding claim 28, in the system of Sullivan, the transaction data comprises a tax status of said buyer.

Regarding claim 31, the system of Sullivan further comprises a location identification system configured to identify a location of said mobile communication device.

Regarding claim 32, in the system of Sullivan, the location identification system comprises at least one of a spatial location and a positional location.

Regarding claim 33, in the system of Sullivan, the telecommunication service provider comprises an Internet Service Provider (ISP) and said mobile communication device is configured in a Voice-over-Internet (VOIP) communication (see, in particular, ¶ 126 and ¶ 131).

Response to Arguments

12. Applicant's arguments filed February 26, 2007 have been fully considered but they are not deemed persuasive.

13. Regarding the arguments with respect to the objection to the references cited in the specification, while hyperlinks may have been deleted, the underlying objection that made the hyperlinks problematic has not been addressed at all, that being the attempt to incorporate by reference materials which are unavailable (i.e., not of record). Applicant can either delete all such references to external materials, or else can simply provide a list and copies of the referenced/cited materials so that the materials are available.

14. Regarding the arguments concerning enablement of the claimed VOIP embodiment, the specification fails to disclose, in an adequately enabling manner, how the tax information (i.e., data) would be communicated to (i.e., loaded into) the portable device solely by means of voice information (i.e., vocally). The rejection has no concern with any claimed intended use wherein the claimed transaction pertains to a purchasing of VOIP services (or any purchasing of any other particular type of product or service), to which the arguments seem directed.

15. Regarding the argument that the system of Sullivan fails to comprise that the "tax directory" is configured to at least one of: "route said transaction to said identified tax authorities," and, "return a list of said identified tax authorities to said personal communication device," the system of Sullivan indeed comprises that the "tax directory" is configured to at least one of: "route said transaction to said identified tax authorities," and, "return a list of said identified tax authorities to said personal communication device," since enabling payment of the appropriate taxes to the pertinent authorities is the express point of the Sullivan system. That is,

Sullivan does not contemplate calculating the taxes merely to collect/charge for the taxes, then keep the taxes without remitting them to the authorities. The system of Sullivan is expressly to ensure compliance with the tax authorities by enabling the user to remit the correct amount(s) to any and all of the relevant authorities for each particular transaction.

16. Regarding the argument that the system of Sullivan fails to return the list of applicable tax authorities to the merchant, the system of Sullivan indeed returns the list of applicable tax authorities to the merchant. See, for example, Figure 15B.

17. Regarding the argument that the system of Sullivan fails to protect the privacy of the transaction, the system of Sullivan indeed protects the privacy of the transaction. See, for example, ¶ 63.

18. Regarding the arguments concerning who in the system of Sullivan sends what to whom, note that Sullivan discloses various embodiments, with the various parties performing various functions, but those various embodiments include an embodiment wherein the merchant reports and remits the collected taxes “directly” to the taxing authorities.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to the disclosure.
20. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

21. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

June 11, 2007



6/11/07

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627